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#6

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Enclosures: Copies of patent owner's Request and Response filed June 2, 1995

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In re reissue application of	:	DECISION TO MERGE
Freeman, et al.	:	REEXAMINATION AND
Serial No. 08/335,891	:	REISSUE PROCEEDINGS
Filed: November 8, 1994	:	
For: U.S. Patent No. 5,088,484	:	
In re Freeman, et al.		
Reexamination Proceeding	:	
Control No. 90/003,586	:	
Filed: October 3, 1994	:	
For: U.S. Patent No. 5,088,484	:	

The "Request" filed June 2, 1995, by Francis A. Paintin, on behalf of the patent owner, entitled REQUEST UNDER 37 CFR § 1.565 TO MERGE REEXAMINATION WITH REISSUE APPLICATION is before the Office of the Deputy Assistant Commissioner for Patent Policy and Projects. The patent owner requests that the reexamination of U.S. Patent No. 5,088,484, Reexamination Proceeding Control No. 90/003,586, be merged with Reissue Application No. 08/335,98.

It is noted that a copy of the response and the request filed June 2, 1995, were not served on the third party requester in the manner set forth in 37 CFR § 1.248 as required by 37 CFR § 1.552(e). Any papers filed in a reexamination proceeding by a patent owner must be served on the third party requester. A copy of the response and request will be sent to the third party requester accompanying this decision.

REVIEW OF FACTS

1. U.S. Patent No. 5,088,484 issued February 18, 1992.
2. On November 8, 1994, a Reissue Application No. 08/335,981 was filed.
3. On October 3, 1994, a request for reexamination of the '484 patent was filed by a third party.
4. On December 22, 1994, reexamination was ordered in Reexamination Proceeding Control No. 90/003,586, and on May 3, 1995, an Office action was issued.

DISCUSSION REGARDING MERGER

Under 37 CFR § 1.565(d):

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings. . . .

As evidenced by the above review of facts, the Reissue Application No. 08/335,981 and the Reexamination Proceeding Control No. 90/003,586 are currently pending. As both the Order pursuant to § 1.525 has been mailed and the time for filing a patent owner statement has expired in the reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reasons for this policy is to prevent inconsistent, and possible conflicting amendments from being introduced into the two proceedings on behalf of the patent owner. Normally the proceedings will be merged whenever it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue prosecution history in Reissue Application No. 08/335,981 shows that the case is awaiting action by the examiner. New claims have been added in the Reissue Application No. 08/335,981. A review of the reexamination file shows that the reexamination is awaiting an Office action by the examiner. The original specification, drawings and patent claims are presently in the reexamination file. The claims are not identical in both proceedings. In order to provide efficient and prompt handling of both proceedings and to prevent inconsistent, and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the Reissue Application No. 08/335,981 and the Reexamination Control No. 90/003,586 will be merged in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND
REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above noted reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the Reissue Application No. 08/335,981 and the reexamination file for purposes of the merged proceedings. The maintenance of identical amendments in the two files is required as long as the proceedings are merged. See 37 CFR § 1.565(d). An appropriate housekeeping amendment is required within one month of this decision placing the same amendments in both proceedings. The patent owner should not address the issues of either proceeding in the housekeeping amendment.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

In view of the fact that the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader reissue application examination. The examiner will apply the reissue statute, rules and case law to the merged proceeding. The examiner's actions will take the form of a single

action which jointly applies to both the Reissue Application No. 08/335,981 and the reexamination proceeding. The action will contain identifying data for both the Reissue Application No. 08/335,981 and the reexamination proceeding and will be physically entered into both files which will be maintained as separate files. Any response by the applicant/patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in both files. Any such responses must be served on the requester who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The Reissue Application No. 08/335,981 will be held abandoned and the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the Reissue Application No. 08/335,981 pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding and continue the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination should be withdrawn (e.g., based on public use or sale) and any new grounds of rejection which are applicable under reexamination (e.g., improper broadened claims) should be made by the examiner upon dissolution of the merged proceeding. The existence of any questions remaining which cannot be considered under reexamination following dissolution of the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

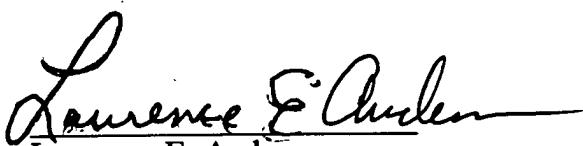
If the Reissue Application No. 08/335,981 ultimately matures into a reissue patent the reexamination proceeding shall be terminated by the grant of the reissued patent and the reissued patent will also serve as the certificate under § 1.570. See MPEP 2285.

Applicant/patent owner is advised that the filing of a file wrapper continuation (FWC) reissue application under 37 CFR § 1.62, whereby the current Reissue Application No. 08/335,981 is considered to be expressly abandoned under § 1.62(g), will most likely result in the dissolution of the merged proceeding, a stay of the FWC reissue application, and separate, continued prosecution of the reexamination proceeding.

IV. Remand for Examination

The above noted Reissue Application No. 08/335,981 and reexamination proceeding are merged. The Reissue Application No. 08/335,981 and the reexamination file are being forwarded to the Director of Examining Group 3300 for examination in accordance with this decision.

Telephone inquiries related to this decision should be directed to Lawrence E. Anderson at 305-9285.



Lawrence E. Anderson
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